



PATENT APPLICATION
RESPONSE UNDER 37 CFR §1.116
EXPEDITED PROCEDURE
TECHNOLOGY CENTER ART UNIT 2626

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Masaaki HORI

Group Art Unit: 2626

Application No.: 09/527,453

Examiner: M. Burleson

Filed: March 17, 2000

Docket No.: 105637

For: COMMUNICATION APPARATUS AND STORAGE MEDIUM

REQUEST FOR RECONSIDERATION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the September 10, 2004 Office Action, the shortened statutory period for reply being extended by the attached Petition for Extension of Time, reconsideration of the rejection is respectfully requested in light of the following remarks.

Claims 1-21 are pending herein.

I. Information Disclosure Statement

Applicant notes with appreciation that the Office Action indicates that the Information Disclosure Statement (IDS), submitted on March 17, 2000, is being considered by the Examiner. However, an Information Disclosure Statement was also filed on May 7, 2004. Applicant requests that the Patent Office acknowledge consideration of the references cited in both the March 17, 2000 and May 7, 2004 IDS's. As a courtesy to the Examiner, Applicant herein encloses a copy of the Form PTO-1449 for each of the March 17, 2000 and May 7, 2004 IDS's.

Applicant respectfully requests the Examiner to initial each of the references cited in the Forms PTO-1449 and return the executed forms to Applicant.

II. Rejection Under 35 U.S.C. §103(a)

Claims 1-21 were rejected under 35 U.S.C. §103(a) over U.S. Patent Publication No. 2002/0048040 (Kato) in view of U.S. Patent No. 5,734,901 (Sidhu). This rejection is respectfully traversed.

According to 35 U.S.C. §103(c), subject matter which qualifies as prior art only under one or more of subsections 102(e), (f) and (g), shall not preclude patentability under 35 U.S.C. §103 where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Kato cannot be relied upon in an obviousness rejection under 35 U.S.C. §103(a) because (1) Kato is commonly owned with the present application, and (2) Kato was published after the present application's March 17, 2000 filing date, so that Kato is a reference only under §102(e).

Accordingly, as noted in the Amendment filed May 14, 2004, Kato, which is commonly owned with the present application and is available as a reference only under 35 U.S.C. §102(e), cannot be relied upon under 35 U.S.C. §103(a).

Furthermore, Sidhu, as acknowledged by the Patent Office, fails to teach or suggest all of the features recited by claims 1-21.

For at least the foregoing reasons, reconsideration and withdrawal of the rejection are respectfully requested.

III. Kato Priority Application

The Laid-Open publication of the Japanese priority application (Japanese application no. 9-343910) of Kato is JP-A-11-161568 (copy enclosed), which published on June 18, 1999, i.e., prior to the March 17, 2000 U.S. filing date of the present application.

However, the June 18, 1999 publication date of JP-A-11-161568 is after the March 19, 1999 filing date of the priority application (Japanese Application No. 11-074808) of the present application. Because Applicant's priority document (Japanese Application No. 11-0747808) fully supports claims 1-21, JP-A-11-161568 is not available as a reference against claims 1-21. For the convenience of the Examiner, Applicant is in the process of obtaining a verified English-language translation of Japanese Application No. 11-074808, and will subsequently submit the verified translation to the Patent.

IV. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-21 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



James A. Oliff
Registration No. 27,075

Linda M. Saltiel
Registration No. 51,122

JAO:LMS/al

Attachments:

Forms PTO-1449
Petition for Extension of Time
JP-A-11-161568

Date: January 21, 2005

OLIFF & BERRIDGE, PLC
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Telephone: (703) 836-6400

<p>DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 15-0461</p>
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Form PTO-1449
(REV. 8-83)US Dept. of Commerce
PATENT & TRADEMARK OFFICEATTY DOCKET NO.
105637APPLICATION NO.
09/527,453

INFORMATION DISCLOSURE STATEMENT

(Use several sheets if necessary)

APPLICANT(S)
Masaaki HORIFILING DATE
March 17, 2000GROUP
2626

U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB CLASS
		5,734,901	03/31/98	SIDHU et al.		

FOREIGN PATENT DOCUMENTS

		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB CLASS

OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, etc.)

EXAMINER

DATE CONSIDERED

Examiner: Initial if citation considered, whether or not citation is in conformance with M.P.E.P. 609; draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

Date: May 7, 2004

Form PTO-1449 (REV. 8-83)		US Dept. of Commerce PATENT & TRADEMARK OFFICE		ATTY DOCKET NO. 105637		APPLICATION NO. New U.S. Patent Application	
INFORMATION DISCLOSURE STATEMENT (Use several sheets if necessary)				APPLICANT(S) Masaaki HORI			
				FILING DATE March 17, 2000		GROUP	

U.S. PATENT DOCUMENTS						
EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB CLASS

FOREIGN PATENT DOCUMENTS						
		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB CLASS
		JP-A-5-68051	3/1993	JAPAN		
		JP-A-8-23434	1/1996	JAPAN		
		JP-A-10-93800	4/1998	JAPAN		
		JP-A-10-150461	6/1998	JAPAN		
		JP-A-9-307731	11/1997	JAPAN		
		JP-A-10-307769	11/1998	JAPAN		
		JP-A-5-37554	2/1993	JAPAN		
		JP-A-6-104921	4/1994	JAPAN		

OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, etc.)		

EXAMINER	DATE CONSIDERED
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Examiner: Initial if citation considered, whether or not citation is in conformance with M.P.E.P. 609; draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

March 17, 2000